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10/083,250	02/27/2002	Geoffrey Stiff	52493.000251	2570
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HUNTON & WILLIAMS LLP			SWARTZ, JAMIE H	
INTELLECTUAL PROPERTY DEPARTMENT				
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			05/14/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/083,250	STIFF ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAMIE H. SWARTZ	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 February 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 30-36 and 45-57 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 30-36 and 45-57 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/20/2007.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.



## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in response to the amendment filed on February 6, 2008. Claims 30-36 and 45-57 are pending. No claims have been added. No claims have been amended.

### ***Response to Arguments***

2. Applicant's arguments filed February 6, 2008 have been fully considered but they are not persuasive.

3. The applicant argues the 35 U.S.C. 112 rejection on claim 30 by pointing to portions of the specification (Applicants Arguments, pg 3). However, the applicant underlined portions of the specification that say "if the benefit level is less than the guaranteed minimum periodic retirement income payment..." Claim 30, claims "if the periodic retirement income payment amount is less than the guaranteed minimum payment amount..." It is unclear whether or not the applicant is stating that "benefit level" is the "periodic retirement income payment." The benefit level is associated with an "income payment." However, the "periodic retirement income payment amount" is associated with a "minimum payment amount." A payment amount can be a number or balance. If a boss knows the amount someone is paid, this does not mean that that amount is paid to a boss; it is only a value or number. However, a "periodic retirement income payment" is a physical payment that is made. Thus the portion of the

specification which was pointed to by the applicant does not point to what was claimed. It is still unclear how if a guaranteed minimum periodic retirement income payment amount is not fully met there would be a remaining balance to be put in an adjustment account.

4. The applicant argues that Dellinger (U.S. Patent 7,089,201) does not teach storing a balance in an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum period retirement income payment amount. The examiner respectfully disagrees. Dellinger teaches adjustments made to an amount with deposit or excess withdrawal depending on the amount acquired (see also col. 11, line 56 - col. 12, line 35, col. 13, line 50 - col. 14, line 10). This corresponds to an adjustment made and storing the balance in an account. Regarding claims 30 and 55, the applicant states "wherein the periodic retirement income payment amount is greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount..." and then later "with the adjustment module storing a balance in an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount." (emphasis added ) The claims use the word "if" which offers a negative recitation and thus "adjustment module storing a balance in an adjustment account" is not given any patentable weight because the claim offers three separate options; greater than, equal to, or less and does not require that the periodic retirement income payment amount be less than the guaranteed minimum periodic retirement income payment amount. Since the periodic

retirement income payment amount is not required to be less than the guaranteed minimum periodic retirement income payment amount there is no requirement for an adjustment account.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 30-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding claim 30, the phrase "the adjustment module storing a balance in an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum period retirement income payment" renders the claim indefinite. It is unclear to the examiner how a balance would be stored in the adjustment account. If the periodic retirement income payment is less than the guaranteed minimum payment wouldn't the "balance" be a negative value? Thus there would be no balance to store into the adjustment account.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 30-36 and 45-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Dellinger et al. (US 7089201 B1).

10. Regarding claim 30, Dellinger teaches a system for providing a user with a plurality of guaranteed minimum retirement income payments (see at least abstract, col. 4, lines 30-46, Fig 5). Dellinger teaches an equity module to receive an income generating payment and to output a periodic retirement income payment amount wherein the periodic retirement income payment amount is greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount if the income generating payments received are received according to a predetermined payment schedule (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5). Dellinger teaches an adjustment module for comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount, and for outputting to the user at least the guaranteed minimum periodic retirement income payment amount, with the adjustment module storing a balance in an adjustment account if the periodic retirement income payment

amount is less than the guaranteed minimum periodic retirement income payment amount (see at least col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5).

11. Regarding claim 31, Dellinger teaches wherein the equity module comprises at least one of a variable annuity module, a fixed annuity module, a mutual funds module, a variable life module, a single premium immediate annuity (SPIA) module, and an immediate variable annuity module (see at least col. 4, line 30 – col. 6, line 12).

12. Regarding claim 32, Dellinger teaches wherein the periodic retirement income payment may be calculated at one of the following annually, biennially, semi-annually, quarterly, monthly, bi-monthly, semi-monthly, weekly, and bi-weekly (see at least col. 7, lines 20-35, col. 12, line 60 – col. 13, line 5).

13. Regarding claim 33, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount may be calculated at one of the following annually, biennially, semi-annually, quarterly, monthly, bi-monthly, semi-monthly, weekly, and bi-weekly (see at least col. 12, line 60 – col. 13, line 5).

14. Regarding claim 34, Dellinger teaches wherein the adjustment account balance is recovered by the performance of a unitized investment trust or an index (see at least col. 10, lines 3-15, col. 13, line 50 – col. 14, line 2).

15. Regarding claim 35, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount is predetermined by the user (see at least col. 10, line 40-48, abstract).

16. Regarding claim 36, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount is predetermined by the total premium payments made by the user during an accumulation period (see at least col. 18, lines 27-36).

17. Regarding claim 45, Dellinger teaches wherein the output of the adjustment module to the user is based on the balance in the adjustment account (see at least col. 5, lines 16-36, col. 11, lines 49-57).

18. Regarding claim 46, Dellinger teaches wherein the output of the adjustment module to the user is equal to the periodic retirement income payment amount, if the adjustment account balance is zero and the periodic retirement income payment amount is greater than the guaranteed minimum periodic retirement income payment amount (see at least col. 15, line 64 – col. 16, line 23, col. 8, lines 49-59, col. 11, lines 16-35).

19. Regarding claim 47, Dellinger teaches wherein the income generating payment comprises a plurality of predetermined scheduled premium payments (see at least col. 4, line 30 – col. 6, line 12, col. 13, lines 50 – col. 14, line 2).

20. Regarding claim 48, Dellinger teaches wherein the income generating payment comprises a plurality of predetermined premium payments (see at least col. 4, line 30 – col. 61, line 12, col. 18, lines 13-60).

21. Regarding claim 49, Dellinger teaches wherein the income generating payment comprises a single premium payment (see at least col. 10, line 56 – col. 11, line 17).

22. Regarding claim 50, Dellinger teaches wherein the income generating payment comprises a plurality of premium payments (see at least col. 18, lines 15-67).

23. Regarding claim 51, Dellinger teaches wherein the guaranteed minimum periodic retirement income payment amount is determined by the amount and timing of the premium payments made by the user during the accumulation period (see at least col. 18, line 15-67, col. 4, line 30 – col. 6, line 12).

24. Regarding claim 52, Dellinger teaches wherein the adjustment account balance is forgiven as a death benefit during the annulization period or at the expiration of the certain period, whichever occurs later (see at least abstract, col. 10, line 56 – col. 11, line 3, col. 11 lines 40 –49, col. 12, lines 10 –35, col. 14, lines 3 – 21).

25. Regarding claim 53, Dellinger teaches wherein an administrator retains a secured interest in future periodic retirement income payment amounts, if the adjustment account reflects a balance (see at least col. 4, line 55 – col. 5, line 16, col. 12, lines 43 –60, col. 14, lines 3-10, and lines 43 – 61).

26. Regarding claim 54, Dellinger teaches wherein the administrator is a financial services carrier (see at least abstract, claim 25).

27. Regarding claim 55, Dellinger teaches a method for providing a user with a plurality of guaranteed minimum retirement income payments, comprising: receiving an income generating payment at an equity module (see at least abstract, col. 4, lines 30-46, Fig 5) Dellinger teaches outputting a periodic retirement income payment amount, using the equity module, wherein the periodic retirement income payment amount is greater than, equal to, or less than a guaranteed minimum periodic retirement income payment amount if the income generating payments received are received according to a predetermined payment schedule, and wherein the guaranteed minimum periodic retirement income payment amount is defined by the user (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5, col. 18, lines 15-67). Dellinger teaches comparing the periodic retirement income payment amount and the guaranteed minimum periodic retirement income payment amount using an adjustment module (see at least col. 15, lines 35-63, col. 16, lines 37 – 57, col. 4, line 55 – col. 6, line 12). Dellinger teaches outputting, using the adjustment module, to the user at least

the guaranteed minimum periodic retirement income payment amount, the adjustment module storing a balance in an adjustment account if the periodic retirement income payment amount is less than the guaranteed minimum periodic retirement income payment amount (see at least col. 4, line 30-46, Fig. 5, col. 8, lines 35-50, col. 8, line 66 – col. 9, line 5, col. 18, lines 15-67, col. 5, lines 16-36, col. 11, lines 49 –57).

28. Dellinger teaches forgiving the adjustment account balance as a death benefit during the annuitization period or at the expiration of the certain period, whichever occurs later (see at least abstract, col. 10, line 56 – col. 11, line 3, col. 11 lines 40 –49, col. 12, lines 10 –35, col. 14, lines 3 – 21).

29. Dellinger teaches wherein the equity module comprises and equity indexed annuities or an equity indexed immediate annuities (see at least col. 10, lines 3-15, col. 13, line 50 – col. 14, line 2).

30. The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as

well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Conclusion***

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE H. SWARTZ whose telephone number is (571)272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. H. S./  
Examiner, Art Unit 3694

/James P Trammell/  
Supervisory Patent Examiner, Art Unit 3694